



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,686	08/31/2001	Jeffrey T. Aguilera	10002629-1	2107

7590 09/22/2006
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
CHUONG, TRUC T	
ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/944,686	Applicant(s) AGUILERA ET AL.	
	Examiner Truc T. Chuong	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-12,14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-12,14 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is responsive to the Amendment and Declaration, filed 06/23/06.

Claims 1-2, 4-6, 8-12, 14, and 17-19 are pending in this application. This is made final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to the Remarks and Declaration

1. The Declaration filed on 06/23/06 under 37 CFR 1.131 has been considered but is ineffective to overcome Czysteczewski et al. (U.S. Patent No. 6,867,876 B1).

The following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

In this case, required by the law that inventor Mr. Jeffrey Aguilera has to sign on the Declaration. The applicant needs to follow:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

- (a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration

in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(g), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(g), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the Official Gazette. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

[47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983,

Art Unit: 2179

effective Feb. 27, 1983; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

2. The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged.

Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. *Ex parte Homan*, 1905 C.D. 288 (Comm'r Pat. 1905);

(H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception. Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d). A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated

i.e., If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others. Note the Exhibit 1 includes page 1 of 3 and 3 of 3, page 2 of 3 is missing. However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all

Art Unit: 2179

claimed limitations, provided that any missing limitation is supported by the declaration itself.

Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, “there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice.” *In re Asahi /America Inc.*, 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995) (Citing *Newkirk v. Lulejian*, 825 F.2d 1581, 3 USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The facts to be established under 37 CFR 1.131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his or her remedy is by appeal from the continued rejection. See MPEP § 2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice. For the most part, the terms “conception,” “reasonable diligence,” and “reduction to practice” have the same meanings under 37 CFR 1.131 as they have in interference proceedings. However, in *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979), the court stated:

The purpose of filing a [37 CFR 1.]131 affidavit is not to demonstrate prior invention, per se, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b)

Art Unit: 2179

parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, “[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity.” Id. at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, “the conception’ and reduction to practice’ which must be established under the rule need not be the same as what is required in the interference’ sense of those terms.” Id.; accord, In re Borkowski, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).

In the Exhibit 1, the Applicants have not clearly show in details how to solve the problem as stated in claims 1 and 14 of the application; and nowhere in the Exhibit 1 mentions a duplicator, selectable icons, and selectable menu items. Claims do not appear to be supported by the evidence provided in claims. It means that there is not enough evidence to clearly prove the relationships between the Exhibit 1 and the Claims.

Claim Rejections - 35 USC § 102

3. Claims 1-2, 4-6, 8-12, 14, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Czyszczewski et al. (“Czyszczewski”, U.S. Patent No. 6,867,876 B1).

As to claims 1, 10, and 14, Czyszczewski provides a user interface comprising a simultaneous display of a plurality of first selectable icons each representing a different duplicator (figs. 9A-C show plurality of icons each representing a different duplicator such as Copy/Printer, Fax, etc., and Czyszczewski also shows document(s) can be sent to multiple destinations such as printers, fax machines, etc., e.g., col. 7 lines 25-35) and a single second selectable icon that when selected actuates the duplicators represented by a selection more than

Art Unit: 2179

one of the first selectable icons {After the destinations (printers, fax machines, and other output devices can be chosen at the same time) are selected by tabbing and selecting different icons such as Copy/Print, Fax, Email, etc., then the user can click Start button as shown in figs. 9A-B to send the print job to the different destinations, e.g., col. 12 lines 42-60, and figs. 9A-B}.

As to claim 2, Czyszczewski shows the user interface as defined in Claim 1, wherein:

the simultaneous display of the selectable icons is a menu screen; and

each selectable icon is a menu item (Czyszczewski inherently shows this feature because Czyszczewski clearly mentions that there are more than one printers can be used as destinations, so in fig. 9A, there are not just B&W printer listed on the menu; there must be more printers on the menu. The similar example can be found in figs. 9B-C shown a list of fax machines/numbers to be selected).

As to claim 4, Czyszczewski teaches the user interface as defined in Claim 1, wherein the actuation of the plural duplicators occurs in a chronological sequence selected by the user on the UI (tabbing and selecting from one to another icons such as Copy/Print, Fax, Email, etc., then the user can click Start button as shown in figs. 9A-B to send the print job to the different destinations, e.g., col. 12 lines 42-60, and figs. 9A-B).

As to claim 5, Czyszczewski teaches the user interface as defined in claim 1, wherein the actuation of plural duplicators selected by a user on the UI occurs simultaneously (the destinations (printers, fax machines, and other output devices can be chosen at the same time) are selected by tabbing and selecting different icons such as Copy/Print, Fax, Email, etc., then the user can click Start button as shown in figs. 9A-B to send the print job to the different destinations, e.g., col. 12 lines 42-60, and figs. 9A-B).

As to claim 6, Czyszczewski teaches the user interface as defined in Claim 1, wherein the actuation of the plural duplicators selected by a user on the UI occurs chronologically, simultaneously, or both (tabbing and selecting from one to another icons such as Copy/Print, Fax, Email, etc., then the user can click Start button as shown in figs. 9A-B to send the print job to the different destinations, e.g., col. 12 lines 42-60, and figs. 9A-B).

As to claims 8-9, and 11-12, Czyszczewski teaches the user interface as defined in Claim 1, wherein each said duplicator has the capability of performing one or more functions selected from the group consisting of printing, magnetic tape recording (figs. 9A-C show plurality of icons each representing a different duplicator such as Copy/Printer, Fax, etc., and Czyszczewski also shows document(s) can be sent to multiple destinations such as printers, fax machines, etc., e.g., col. 7 lines 25-35), photo imaging substrate recording, recording an optically scanned image onto a magnetic media storage device, magneto optical writing, and electromagnetic radiation broadcasting transmission.

As to claims 17-18, they are method claims of system claims 8-9. Note the rejection of claims 8-9 above respectively.

As to claim 19, this is a computer program product claim of method claim 14. Note the rejection of claim 14 above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 2179

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T. Chuong whose telephone number is 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Truc T. Chuong

09/13/06


WEILUN LO
SUPERVISORY PATENT EXAMINER